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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,219	10/20/2000	Paul Lapstun	NPA031 US	7823
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SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,219

Applicant(s)

LAPSTUN ET AL

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 7, 15-18 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 7, 15-18 and 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 7/14/05.
- Claims 1, 6-7, 15-18, 22-30 are pending; claims 2-5, 8-14, and 19-21 have been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 & 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly added features/limitations as cited in claim 1 “including visible markings” is unclear. The examiner is unclear whether “visible markings” as cited refers to both visible markings associated with digital ink and visible markings not associated with digital ink or one of visible markings. Herein, the examiner interprets visible markings cited as visible markings not associated with digital inks.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. “A detector for detecting the coded data” as cited in claim 18 is unclear. The examiner is unclear the applicant is referring to “coded data” or “invisible coded data”. Herein, the examiner interprets as “coded data”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-7, 15-18, 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al (US 6537324), and in view of Dymetman et al (US 6330976), and further in view of Kessler (US 20010010195).

Regarding claim 18, Tabata discloses a system enabling the copying of documents, including:

- a scanner (scanner 60, fig. 1, col. 5, lines 40-58) for scanning a document (medium form which contains both coded data and document data, fig. 2, col. 5, lines 40-58) that contain coded data indicative (barcode data incorporated a linkage information for identifying correlated information file from the file server, fig. 2, col. 5, lines 50-67 to col. 6, lines 1-67 and col. 8, lines 62-67) of an identity of the document and enabling formation of a digital image of the document;
- a detector (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10) for detecting the coded data;
- a data store including data (file server 20 for storing correlated information files, fig. 1, col. 5, lines 20-58 and col. 6, lines 10-25) representing document content; and

However, Tabata fails to teach and/or suggest a document includes visible markings associated with digital ink, visible markings not associated with digital ink, and wherein a printer only duplicates the markings associated with digital ink but does not duplicates the markings not associated with digital ink.

Dymetman, in the same field of endeavor for scanning coded data, teaches a document includes markings associated with digital ink (pointer 502 includes pen-like instrument for writing digital ink onto a coded substrate and/or any ordinary writing surface, figs. 1 & 9, col. 22, lines 10-65), markings not associated with digital ink, and wherein a printer (facsimile apparatus as taught by Dymetman for faxing only messages written with digital ink, col. 22, lines 10-65) only duplicates the markings associated with digital ink but does not duplicates the markings not associated with digital ink.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the system of Tabata to include a printer and/or

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facsimile apparatus as taught by Dymetman for reading document that includes markings with digital inks and markings without digital inks and duplicates markings with digital ink because of a following reason: (●) using pen-like pointer 502 (fig. 1) for writing digital inks coded data and/or any ordinary writing surface and only transmits (i.e. faxing) markings with digital ink (i.e. messages written with pen-like pointer) rather than all the contains within a document; therefore, reducing transmission time.

The combinations of Tabata and Dymetman fail to teach and/or suggest a printer adapted for printing a copy of the document including visible markings, and at the same time, printing on the printed copy, using the same printer, invisible coded data indicative of an identify of the copy.

Kessler, in the same field of endeavor for printing, teaches a printer adapted for printing a copy of the document including visible markings, and at the same time, printing on the printed copy, using the same printer, invisible coded data indicative of an identify of the copy (simultaneously printing both visible and invisible markings, page 6, 2nd column, lines 8-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the system of Tabata and Dymetman to include a printer as taught by Kessler for printing both visible and invisible markings simultaneously because of a following reason: to increase output production by printing both visible and invisible markings simultaneously.

Therefore, it would have been obvious to combine Tabata, Dymetman, and Kessler to obtain the invention as specified in claim 18.

Regarding claim 22, Dymetman further teaches a sensing device operable by a user to identify said coded data printed on said copy (sensing device 502 for detecting/sensing coded data, figs. 1, 14-15, cols. 3-4 and col. 8, lines 45-67).

Regarding claim 23, Dymetman further teaches the sensing device including a marking nib (marking tip 505, fig. 11).

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Regarding claim 24, Dymetman further teaches the sensing device including an identification means (network address of the sensing device, col. 9, lines 16-45), which imparts a unique identity to the sensing device, the system able to associate the identifier for the copy with the identity of the sensing device.

Regarding claims 25-26, the printer including a binder for binding pages of a multi-page copy and wherein scanner and the printer being provided as parts of a single apparatus (multifunctional copy machine including scanning, faxing, printing, and stapling functions are known in the art).

Regarding claim 27, Tabata further discloses a system according to claim 18, the scanner and the detector being provided as parts of a single apparatus (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10).

Regarding claim 28, Tabata further discloses a system according to claim 27, the scanner comprising a moving linear image sensor device (all scanners include a CCD for reading images, fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10), the detector carried by this device.

Regarding claim 29, Dymetman further teaches the sensing device adapted to communicate with a base station (fig. 2 as per teaching of Dymetman), the scanner and base station (scanner, fig. 1, as per teachings of Tabata) provided as parts of a single apparatus.

Regarding claim 30, Tabata further discloses a system according to claim 18 including authorization means to prevent use by an unauthorized user (user ID and passwords, col. 15, lines 20-60).

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Regarding claims 1, 6-7, 15-17: Claims 1, 6-7, 15-17 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 18, 22-30; therefore, claims 1, 6-7, 15-17 are rejected for the same rejection rationale/basis as described in claims 18, 22-30 above.

Response to Arguments

Applicant's arguments with respect to claims 1 & 18 have been considered but are moot in view of the new ground(s) of rejection due to newly added features/limitations.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham


GABRIEL GARCIA
PRIMARY EXAMINER